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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,654	08/03/2001	Anshul Amar	AHC-001	5834
42532	7590	01/13/2006	EXAMINER	
PROSKAUER ROSE LLP ONE INTERNATIONAL PLACE 14TH FL BOSTON, MA 02110			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/921,654	Applicant(s) AMAR ET AL.	
	Examiner Natalie A. Pass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>30/9/02 & 06/12/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 3 August 2001. Claims 1-20 are pending. The Information Disclosure Statements submitted 30 September 2002 and 10 December 2001 have been entered and considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 9 recites the limitation "the patient visit" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-8, 13-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Burks et al., U.S. Patent Number 6, 453, 297.

(A) As per claim 1, Burks teaches a method for managing a medical practice comprising:

(a) communicating with a medical practice client user interface over a first communications network (Burks; column 3, lines 9-15);

(b) communicating with a payor server over a second communications network (Burks; column 3, lines 33-36);

(c) receiving information associated with an event related to a patient from at least one of the medical practice client user interface and the payor server (Burks; column 6, lines 8-19);

(d) performing one or more tasks associated with the event (Burks; column 6, lines 15-19);

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(e) using at least a portion of the information associated with the event to create an insurance claim following completion of the one or more tasks (Burks; column 6, lines 19-24); and

(f) automatically and repeatedly interacting with the information associated with the event in connection with the performed tasks by at least one of applying one or more rules in a set of rules and performing transactions with the “trading partner” (reads on “payor”) server (Burks; column 3, line 60 to column 4, line 6).

(B) As per claims 2-6, Burks teaches a method as analyzed and discussed in claim 1 above

further comprising verifying the information at least one of before, during, and following performing the tasks associated with the event (Burks; column 3, line 65 to column 4, line 4, column 5, lines 37-40);

further comprising the steps of:

(g) receiving an error notification (Burks; column 6, lines 49-52); and

(h) performing a correcting action in response thereto (Burks; column 9, lines 45-60);

wherein the performing the correcting action further comprises transmitting an error message denoting an error to the medical practice (Burks; column 6, lines 47-59, column 9, lines 45-49);

wherein the correcting action comprises correcting at least one of a typographical error, a formatting error, and “insufficient” (reads on “incomplete”) information (Burks; column 10, lines 44-51); and

further comprising generating the error notification (Burks; column 6, lines 47-51).

(C) As per claims 7-8, 13-14 Burks teaches a method as analyzed and discussed in claims 1 and 2 above

further comprising submitting the claim to the “trading partner” (reads on “payor”) server over the second communications network (Burks; column 3, line 60 to column 4, line 6);

further comprising updating the “formats” (reads on “rules”) in the set of rules (Burks; column 5, line 66 to column 6, line 19);

wherein the performing of the tasks following the event further comprises the step of receiving a claim (Burks; column 5, lines 51-54); and

wherein the transactions performed with the payor server further comprises claim submittals (Burks; column 5, lines 34-36).

(D) Claim 15 differs from method claim 1, in that it is a system rather than a method for managing a medical practice.

System claims 15 and 19 repeat the subject matter of claims 1 and 14, respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 1 and 14 have been shown to be fully disclosed by the teachings of Burks in the above rejection of claims 1 and 14, it is readily apparent that the system disclosed by Burks includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

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(E) As per claims 16-18 Burks teaches a method as analyzed and discussed in claim 15 above

further comprising a patient information database (Burks; column 4, lines 29-31) and an insurance information database (Burks; column 3, lines 60-62, column 6, lines 21-29, column 7, lines 40-44);

wherein the rules engine further comprises a rules database to store the set of rules (Burks; column 3, lines 45-62, column 3, line 65 to column 4, line 4); and

wherein the workflow processing engine further comprises a verifier to verify the information at least one of before, during, and following performing the tasks associated with the event (Burks; column 6, lines 34-59).

(F) Claim 20 differs from method claim 1, in that it is a system rather than a method for medical practice management.

System claim 20 repeats the subject matter of claim 1, respectively, as a set of “means-plus-function” elements rather than a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the teachings of Burks in the above rejection of claim 1, it is readily apparent that the system disclosed by Burks includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297 as applied to claims 1 and 2 above, and further in view of Berman et al., U.S. Patent Number 5, 995, 939.

(A) As per claim 9, Burks teaches a method as analyzed and discussed in claims 1 and 2 above.

Although Burks teaches performing tasks associated with an event such as a patient visit (Burks; column 6, lines 8-19),

Burks fails to explicitly disclose a method wherein the performing of the tasks before the patient visit further comprises the steps of at least one of

receiving a request for an appointment,
searching for the patient in a patient information database,
receiving insurance information,
receiving referral information, and
receiving a proposed schedule appointment.

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However, the above features are well-known in the art, as evidenced by Berman.

In particular, Berman teaches

wherein the performing of the tasks before the patient visit further comprises the step of receiving referral information (Berman; column 4, lines 7-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Burks to include receiving referral information, as taught by Berman, with the motivations of improving efficiency in managing medically-related information by handling referrals and authorizations electronically, resulting in reducing the “endlessly spiraling costs” in the health care industry (Berman; column 1, line 15 to column 2, line17).

(B) As per claim 10-11, Burks and Berman teach a method as analyzed and discussed in claims 1, 2 and 9 above.

wherein the receiving insurance information further comprises the steps of parsing or analyzing the insurance information and determining whether the patient is eligible (Berman; column 4, lines 13-14); and

wherein the receiving referral information further comprises defining a referral rule category, an appointment type class, and an intersection of the referral rule category and the appointment type class (Berman; column 4, lines 3-24, column 7, lines 23-35, 44-49).

The motivations for combining the respective teachings of Burks and Berman are as given in the rejection of claim 9 above, and incorporated herein.

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8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burks et al., U.S. Patent Number 6, 453, 297 as applied to claims 1 and 2 above, and further in view of Ilsen et al., U.S. Patent Number 6, 757, 898.

(A) As per claim 12, Burks teaches a method as analyzed and discussed in claims 1 and 2 above.

Although Burks teaches performing tasks associated with an event such as a patient visit (Burks; column 6, lines 8-19),

Burks fails to explicitly disclose a method

wherein the tasks performed during the event further comprise at least one of performing check-in tasks and performing check-out tasks.

However, the above features are well-known in the art, as evidenced by Ilsen.

In particular, Ilsen teaches

wherein the tasks performed during the event further comprise at least one of performing check-in tasks and performing check-out tasks (Ilsen; column 13, lines 22-24).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Burks to include these limitations, as taught by Ilsen, with the motivations of restoring communications between doctors and their patients, for enhancing service to patients, and for expanding the capacity of the medical practice, without additional work by the doctor or his/her staff (Ilsen; column 3, lines 62-66).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Lowrey et al., U.S. Patent Number 6, 374, 229, Costello, U.S. Patent Application Number 2002/0022872, Campbell et al., U.S. Patent Number 6, 047, 259, Lencki et al., U.S. Patent Application Number 2002/0049617, Howes, U.S. Patent Number 6, 738, 784 and Cummings, Jr. et al., U.S. Patent Number 6, 345, 260 teach the environment of electronic management of medical offices.

10. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. After Final communications should be labeled "Box AF."

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

January 5, 2006


C. LUKE GILLIGAN
PATENT EXAMINER